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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,547	01/25/2002	Eric Wolfgruber	02-121	3047

7590

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 10/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

**Office Action Summary**

Application No.

10/057,547

Applicant(s)

WOLFSGRUBER ET AL.

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2002 and 30 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/647,547.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## SECOND OFFICE ACTION

### *Amendment*

1. This Office Action is in response to the Amendment Under 37 C.F.R. 1.111(c) received July 19, 2002 and the Supplemental Amendment received July 30, 2002.

### *Claim Rejections - 35 USC § 112, First Paragraph*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 11-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear where support can be found in the original disclosure for the limitation "metallurgically bonded" (e.g. independent claim 1, line 3). Although applicant's original disclosure describes various embodiments of applicant's invention, clear support for an embodiment commensurate in scope with the limitation "metallurgically bonded" has not been found.

### *Claim Rejections - 35 USC § 112, Second Paragraph*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. It is indefinite as to what shape is "a demolded, mold shaped foamed metal body" (e.g. see independent claim 11, lines 1-2; independent claim 18, lines 1-2). Since a mold can make articles of any shape, it is not clear what physical shapes are included or excluded by this recitation of a demolding operation. It is also not clear how applicant intends for the explicit recitation of a demolding step to affect the physical characteristics of the article.

7. It is indefinite as to what further physical limitation is introduced by the phrase "form fitted" (e.g. claim 18, line 3). It is also unclear how applicant intends the phrase "form fitted" to be interpreted in the context of the claim limitations.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in

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section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

9. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Niebylski (U.S. Patent 3,834,881).

10. Niebylski discloses an article comprising a foamed metal body having embedded metal structural sheet elements sandwiching foamed metal slabs (e.g. see the figure). Although Niebylski may form the article by a different method than the molding method used by applicant, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. The shape of the physical structure of the reference is no different than the shape of a structure that could be produced as a demolded foamed metal body. The limitation "form fitted" does not add any further structure to the element than that contained in the element of the reference.

11. Claims 11-13 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Valdo (U.S. Patent 3,848,666).

12. Valdo discloses an article comprising a foamed metal body having embedded metal structural elements (e.g. tubes, blocks or plates) which act as reinforcements (e.g. see column 5,

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lines 8-41). In addition, although Valdo's finished panel may not require forms sandwiching the foamed panel, the intermediate form of the panel during manufacture is encased by metal mold plates (e.g. see column 3, lines 8-34) and this intermediate form before demolding anticipates the structural requirements of the claims. Although Valdo may form the article by a different method than the molding method used by applicant, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Valdo's metal foaming temperatures would be expected to result in at least some metallurgical bonding with the embedded elements. The shape of the physical structure of the reference is no different than the shape of a structure that could be produced as a demolded foamed metal body. The limitation "form fitted" does not add any further structure to the element than that contained in the element of the reference.

13. Claim 11 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Bjorksten (U.S. Patent 3,941,182).

14. Bjorksten discloses an article comprising a foamed metal body having embedded metal structural reinforcing elements which are coated with an adhesion promoting metal coating (e.g. see column 4, lines 34-55). A metallurgical bond would result from the binary alloy created by the coating. Although Bjorksten may form the article by a different method than the molding method used by applicant, when there is a substantially similar product, as in the applied prior

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art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. The shape of the physical structure of the reference is no different than the shape of a structure that could be produced as a demolded foamed metal body. The limitation "form fitted" does not add any further structure to the element than that contained in the element of the reference.

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15. Claims 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Masuda (U.S. Patent 5,482,533).

16. Masuda discloses a curved steel vessel (e.g. Figure 1A) containing structural elements (rods) and which is filled with foamed metal (e.g. see Figure 1B). The intermediate article during manufacture while encased by the metal mold and containing the rods anticipates the structural requirements of the claims. Although Masuda may form the article by a different method than the molding method used by applicant, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q. 685, and *In re Fessmann*, 180 U.S.P.Q. 324. The shape of the physical structure of the reference is no different than the shape of a structure that could be produced as a demolded foamed metal body. The limitation "form fitted" does not add any further structure to the element than that contained in the element of the reference.

17. Claims 11-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Emmelmann (U.S. Patent 6,135,542).

18. Emmelmann discloses an article comprising a foamed metal body having embedded metal structural elements and sandwiching metal forms (e.g. see Figures 2 and 7; column 3, line 60 - column 4, line 56). The high heat during the foaming step would be expected to produce at least some metallurgical bonding of the components. The shape of the physical structure of the reference is no different than the shape of a structure that could be produced as a demolded



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foamed metal body. The limitation "form fitted" does not add any further structure to the element than that contained in the element of the reference.

### ***Response to Arguments***

19. Applicant's arguments filed July 19, 2002 and July 30, 2002 have been fully considered but they are not persuasive. As noted in the rejection under 35 USC 112, first paragraph, the examiner has not readily found a sufficient basis in the original disclosure for some of the claim limitations. Should applicant find sufficient basis, the rejection will be withdrawn. As noted in the rejection under 35 USC 112, second paragraph, it is indefinite as to what limitations are conferred on the pending article claims by the new limitations. It is indefinite as to what shape is "a demolded, mold shaped foamed metal body" (e.g. see independent claim 11, lines 1-2; independent claim 18, lines 1-2). Since a mold can make articles of any shape, it is not clear what physical shapes are included or excluded by this recitation of a demolding operation. It is also not clear how applicant intends for the explicit recitation of a demolding step to affect the physical characteristics of the article. As noted in the art rejections, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. It is also indefinite as to what further physical limitation is introduced by the phrase "form fitted" (e.g. claim 18, line 3). It is also unclear how applicant intends the phrase "form fitted" to be interpreted in the context of the claim limitations. The shapes of the physical structure of the references are no different than the shape of a structure that could be produced as a demolded

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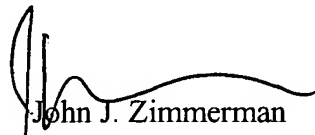
foamed metal body. The limitation "form fitted" does not add any further structure to the element than that contained in the element of the references. Regarding the new limitation requiring metallurgical bonding, the temperatures used in foaming the metals in the references appear to be sufficient to produce at least some metallurgical bonding. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

### ***Conclusion***

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (703) 308-2512. The examiner can normally be reached on 8:30am-5:00pm, M-F. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
October 18, 2002